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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/178,329	10/23/1998	MICHAEL R. NOWAK	053649-0003	4360

7590 01/25/2005

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EXAMINER
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JACKSON, MONIQUE R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 01/25/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/178,329

Applicant(s)

NOWAK ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,8-12,22 and 23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,6,8-12,22 and 23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. The amendment filed 10/20/04 has been entered. Claims 22 and 23 have been added. Claims 1, 5, 6, 8-12 and 22-23 are pending in the application. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

#### ***Claim Rejections - 35 USC § 103***

2. Claims 1, 5, 6, 8-12 and 22-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Finestone et al (USPN 5,244,702) for the reasons recited in the prior office action and restated below, wherein the Examiner notes that the instant claims are directed to the composite wrap material and not the wrapped ream of paper and hence the limitations with respect to “inner” and “outer” recited in Claim 1 and the positional limitations recited in Claims 22-23 constitute intended use and do not provide any patentable weight with respect to the composite.

Finestone et al teach a paper-plastic laminate sheet capable of being converted by conventional equipment into envelopes, grocery bags, and other dilatable container products that initially are in a flat state and are normally made of paper and wherein the products produced are waterproof and the paper facing has an affinity for standard printing inks (Abstract; Col. 2, lines 10-26.) The laminate consists of a paper facing sheet laminated via an adhesive layer to a reinforcing film of oriented polymer such as polypropylene wherein the paper may be of any gauge, weight and quality as appropriate to the end use for which the sheeting is intended such as unbleached Kraft paper, white or colored paper or coated paper (Abstract; Col. 2, lines 66-Col. 3, line 9.) The adhesive layer is preferably a water-based polyacrylate copolymer adhesive or any other water-based adhesive having similar bonding properties and having an affinity both for the paper sheet and the plastic film wherein hot melt adhesives would diminish the reinforcing

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characteristics of the film (Col. 3, lines 28-38.) Finestone et al do not teach that the paper has a basis weight of 20-60 lb/3000 sq ft as instantly claimed, however, Finestone et al do teach that the basis weight may be selected to be appropriate for a particular end use and that the laminate is suitable for products typically produced from flat paper materials, hence, given that ream wrap material is a typical product produced from flat paper materials, it would have been obvious to one having ordinary skill in the art at the time of the invention to determine the optimum basis weight based on the particular end use wherein basis weights within the instantly claimed range are known for producing ream wrap materials. Further, Finestone et al does not specifically teach adhesives as instantly claimed or metallization of the plastic film or the paper sheet, however, one having ordinary skill in the art at the time of the invention would have been motivated to provide a conventional metallized layer to improve barrier properties of the packaging laminate as is well known in the art and to further select from conventional adhesives utilized to bond paper and polymer layers such as those instantly claimed in producing the laminate taught by Finestone et al. In terms of instant Claim 10, the Examiner notes that though Finestone et al teaches away from utilizing heat when producing the laminate, the limitation "hot melt adhesive" is a process limitation wherein the adhesive layer in the final film is not actually hot. Therefore, considering the polyacrylate copolymer taught by Finestone et al as suitable in water-based form may also be characterized as a "hot melt adhesive" in other applications and considering the "hot" limitation is a process limitation, the Examiner takes the position that the invention taught by Finestone et al reads upon the final product of Claim 10 considering the final products appear to be the same.

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***Terminal Disclaimer***

3. The terminal disclaimer filed on 10/20/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent issued on 10/385,117 has been reviewed and is NOT accepted.

a. The person who signed the terminal disclaimer is not recognized as an officer of the assignee, and he/she has not been established as being authorized to act on behalf of the assignee. See MPEP § 324.

An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

4. The terminal disclaimer filed on 12/10/04 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patent issued on 10/385,117 has been received and is being reviewed.

***Response to Arguments***

5. Applicant's arguments filed 10/20/04 have been fully considered but they are not persuasive. The Applicant argues that the composite taught by Finestone et al has an exterior paper layer surface and an interior film layer surface while in the instant invention the paper layer is the interior layer that touches against the rear of paper. In response to applicant's argument, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152

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USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Therefore, as recited above, the Examiner notes that the instant claims are directed to the composite wrap material and not the wrapped ream of paper and hence the limitations with respect to “inner” and “outer” recited in Claim 1 and the positional limitations recited in Claims 22-23 constitute intended use and do not provide any patentable weight with respect to the composite considering the composite taught by Finestone et al is structurally capable of performing the intended use. The Applicant further argues that Claim 10 including the limitation “hot melt adhesive” is not obvious over Finestone et al because Finestone et al teach utilizing a cold lamination process wherein the addition of heat would diminish the reinforcing characteristics of their film. However, as recited above, the Examiner notes that though Finestone et al teaches away from utilizing heat when producing the laminate, the limitation “hot melt adhesive” is a process limitation wherein the adhesive layer in the final composite is not hot. Therefore, considering the polyacrylate copolymer taught by Finestone et al as suitable in water-based form may also be characterized as a “hot melt adhesive” in other applications and considering the “hot” limitation is a process limitation, the Examiner takes the position that the invention taught by Finestone et al reads upon the final product of Claim 10 considering the adhesive in the final product is not hot.

6. Further, based on a telephone conversation with the Applicant's Attorney subsequent to the filing of the amendment dated 10/20/04, the Examiner has considered the Applicant's suggestion of amending the claims to incorporate the actual ream of paper wrapped with the claimed wrapping material comprising the above limitations, however it is noted that Finestone et al teach that a three-ply laminate may be produced wherein the inner layer is paper and hence

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the paper layer would be against the wrapped item. Further, though Finestone et al teach that the paper layer is the exterior surface in order to provide a printable exterior product, the Examiner takes the position that it would have been obvious to one having ordinary skill in the art to determine which surface to utilize as the inner or outer layer based on the desired end use of the wrapping material.

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

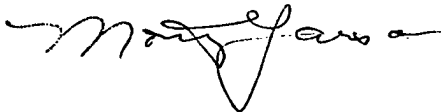
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Monique R. Jackson  
Primary Examiner  
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January 15, 2005